



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/849,513

05/05/2001

Dennis G. Earnshaw

070325-040017

8685

33717

7590

06/26/2007

GREENBERG TRAURIG LLP (LA)

2450 COLORADO AVENUE, SUITE 400E

INTELLECTUAL PROPERTY DEPARTMENT

SANTA MONICA, CA 90404

EXAMINER

VIG, NARESH

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

06/26/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/849,513	<b>Applicant(s)</b> EARNSHAW, DENNIS G.	
	<b>Examiner</b> Naresh Vig	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 14-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 14-20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

This is in reference to response received on 04 April 2007. Claims 1 – 10, 14 – 20 and 22 – 24 are pending for examination.

### ***Response to Arguments***

In response to applicant's argument that cited reference Henry discloses MongoNet which allows users to manually fill out a form with email addresses and scan such form into a fax machine for transmission to the email addresses provided in the form.

However, cited reference teaches a business application can create a business document with the recipient address without requiring a user to manually fill out a form as argued by the applicant.

In response to applicant's argument that cited reference Akimoto teaches nothing on determining preferred communication formats.

However, cited reference does teach that based on the recipients information, Akimoto is capable of delivering the business document to the recipient in the format indicator which is determined by the Akimoto invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 2, 7 – 10, 14, 18 – 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over an IBM Corporation product Facsimile Support/400 hereinafter known as IBM in view of Henry US Patent 6,424,426 and Akimoto US Patent 6,775,711.**

**Regarding claims 1 and 14,** IBM teaches idea of a business transaction document which can be directed to plurality of parties [IBM, page 106], wherein the business document can be sent to a printer as well as to a Facsimile Server [IBM, page 1, 2, 4]. IBM teaches concept of:

creating on a first computer an electronic business transaction document to be directed to a plurality of recipient parties to a business transaction, the electronic business transaction document being created by a business management software program [IBM, page 1, 2, 4]. Even though IBM does not explicitly teach the content of the document, it would have been obvious to one of ordinary skill in the art that business document generated by IBM is capable of including text of a preferred

communication format indicator for each of the plurality of recipient parties of the business transaction, the electronic document being directed to at least one recipient party in a computer communication format and to at least one other recipient party in a non-computer communication format (document can be directed to a remote PC [IBM, Page 1, 2, 144, 146] or sent to a facsimile device [IBM, page 1, 2]). However, Henry teaches idea wherein a business document can be sent by a server to a recipient party in their preferred format (fax-to-email and email-to-fax formats). This clearly teaches the idea that IBM Facsimile Server can be modified to send document as taught by Henry [Henry, Fig. 6 and disclosure associated with the Figure].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify IBM as taught by Henry to enable a user device to send emails from any facsimile capable device and also able to send facsimiles to any other facsimile device, from either a centralized web server or a client machine.

IBM in view of Henry teaches capability for transmitting the electronic business transaction document over the computer network to a network-connected transaction service server computer [IBM, page 1, 2; Henry, Fig. 5 and disclosure associated with Fig. 5];

IBM in view of Henry does not explicitly teach capability for determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction. However, Henry teaches capability of sending a business transaction document to plurality of recipients in their preferred format. Akimoto teaches idea of determining at the transaction service server

computer a preferred communication format for each of the plurality of recipient parties of the business transaction, the preferred communication format being determined by an electronic business management software residing at the transaction service server computer that interprets the preferred communication format indicator of each of the plurality of recipient parties of the business transaction [Akimoto, Fig. 8 and disclosure associated with Fig. 8];

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify IBM in view of Henry as taught by Akimoto to make it possible to add a plurality of new functions with minimal changes to the existing system.

IBM in view of Henry and Akimoto teaches capability wherein:

if the transaction service server computer determines that the preferred communication format of a recipient party is a computer communicating format, sending the electronic business transaction document from the transaction service server computer to a first recipient party using a computer communication format [Akimoto, Fig. 8 and disclosure associated with Fig. 8]; and

if the transaction service server computer determines that the preferred communication format of a recipient party is a non-computer communicating format, sending the electronic business transaction document from the transaction service server computer to a second recipient party using a user preferred non-computer communication format, wherein the user preferred non-computer communication format

Art Unit: 3629

can be telephonic facsimile or regular mail [Akimoto, Fig. 8 and disclosure associated with Fig. 8];

**Regarding claim 19**, as responded to in response to claims 1 and 14, IBM teaches idea of a business transaction document which can be directed to plurality of parties [IBM, page 106], wherein the business document can be sent to a printer as well as to a Facsimile Server [IBM, page 1, 2, 4]. IBM teaches capability for:

receiving from a client computer an electronic business transaction document that is compatible with a business management software program. IBM teaches the electronic business transaction document being directed a communication formats to plural recipient parties to a business transaction [IBM, page 106], the electronic business transaction document being created by a business management software program in the client computer the electronic business transaction document including address information. IBM does not explicitly teach preferred communication format indicator for each of the plurality of recipient parties of the business transaction. However, Henry teaches idea wherein a business document can be sent be a server to a recipient party in their preferred format (fax-to-email and email-to-fax formats). This clearly teach the idea that IBM Fascimile Server can be modified to send document as taught by Henry [Henry, Fig. 6 and disclosure associated with the Figure].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify IBM as taught by Henry to enable a user device

to send emails from any facsimile capable device and also able to send facsimiles to any other facsimile device, from either a centralized web server or a client machine.

IBM teaches using address book [Master List, Distribution List, IBM, page 106] IBM in view of Henry teaches capability for retrieving address information and the preferred communication format from an electronic address book stored at the client computer [Distribution list, master list, IBM, page 106], wherein the electronic business transaction document is received by a transaction service server computer communicated with the client computer through a computer network;

IBM in view of Henry does not explicitly teach determining at the transaction services service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction. However, Akimoto teaches determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction, the preferred communication format being determined by an electronic business management software residing at the transaction service server computer that interprets the preferred communication format indicator of each of the plurality of recipient parties of the business transaction, wherein the electronic business transaction document is received by a transaction service server computer communicated with the client computer through a computer network [IBM, page 1, 2, 4; Akimoto, Fig. 8 and disclosure associated with Fig. 8];

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify IBM in view of Henry as taught by Akimoto to



make it possible to add a plurality of new functions with minimal changes to the existing system.

IBM in view of Henry and Akimoto teaches capability wherein:

if the transaction service server computer determines that the preferred business transaction document communication format of a party is a computer communication format, sending the electronic business transaction document from the transaction service server computer to a first recipient party using a computer communication format [Akimoto, Fig. 8 and disclosure associated with Fig. 8]; and

if the transaction service computer determines that the preferred business transaction document communication format of a party is a non-computer communication format, sending the electronic business transaction document from the transaction service server computer to a second recipient party using a non-computer communication format [Akimoto, Fig. 8 and disclosure associated with Fig. 8].

**Regarding claims 2 and 20,** IBM in view of Henry and Akimoto teaches capability wherein preferred communication format includes telephonic facsimile.

**Regarding claim 7,** as responded to earlier, IBM in view of Henry and Akimoto teaches capability wherein business management software program is capable of automatically extracting and populating information from the electronic business transaction document, transmitting access to the business management software component with the electronic business transaction document in the computer format to

the at least one recipient party, if it is determined that the at least one recipient party is not capable of viewing the electronic business transaction document, the business management software component not being capable of automatically populating and extracting information from electronic business transaction documents (obvious to one of ordinary skill in the art at the time the invention was made that if a user does not have capability for handling electronic file, they will not be able to view the electronic file, for example, a user with computer environment which does not have graphic capability will not be able to recreate graphics to be displayed on their computer).

**Regarding claims 8 – 9**, IBM in view of Henry and Akimoto teaches capability wherein the electronic business transaction document can include a markup language or Extensible Markup Language as content in the computer file.

**Regarding claims 10 and 18**, as responded to earlier, IBM in view of Henry and Akimoto teaches capability wherein business transaction can be related to a construction project.

**Regarding claim 23**, IBM in view of Henry and Akimoto teaches capability for manually changing the preferred communication format automatically associated with the recipient party prior to sending the electronic business transaction document to a recipient party [Akimoto, Fig. 8 and disclosure associated with Fig. 8].

**Claims 3 - 6, 15 – 17, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over an IBM Corporation product Facsimile Support/400 hereinafter known as IBM in view of Henry US Patent 6,424,426, Akimoto US Patent 6,775,711 and NetGram.com hereinafter known as NetGram.**

**Regarding claim 3**, IBM in view of Henry and Akimoto does not explicitly teach the preferred communication format includes regular mail, a printed copy of the electronic business transaction document is mailed to a recipient party. However, Henry in view of Akimoto teaches plurality of tags can be used to indicate different type of delivery means for a recipient [Akimoto, Fig. 7, 8 and disclosure associated with fig. 7, 8]. Also, it is known at the time of invention to one of ordinary skill in the art that businesses have mailed printed copy of business transaction document to recipient party. However, NetGram teaches services for sending sender's electronic document via postal mail to recipient of the document [NetGram page 11 – 13].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify IBM in view of Henry and Akimoto as taught by NetGram to allow senders outsource mailing of their business documents.

**Regarding claims 4 and 15**, IBM in view of Henry and Akimoto does not explicitly teach storing in an electronic address book address information for each party and the preferred communication format indicator for each of the plurality of recipient

Art Unit: 3629

parties of the business transaction indicating the one of the computer and non-computer communication formats in which to transmit communications to the party. However, NetGram teaches address book address information for each party and the preferred communication format indicator for each of the plurality of recipient parties of the business transaction [NetGram page 4].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify IBM in view of Henry and Akimoto and use address book of NetGram to store preferred communication format indicator for each recipient parties to allow the senders to reuse previously stored addresses in the electronic address book. Also, For example, email services like AOL which teaches address book for their subscribers.

**Regarding claims 5, 16 and 22,** IBM in view of Henry, Akimoto and NetGram teaches adding a recipient party to the electronic business transaction document automatically associates with the recipient party the preferred communication format indicator.

**Regarding claims 6, 17 and 24,** IBM in view of Henry and Akimoto does not explicitly teach charging a fee for each recipient party to which the electronic business transaction document is sent from the transaction service server computer. However, NetGram teaches to charge fee to sender [NetGram 9].

Art Unit: 3629

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify IBM in view of Henry and Akimoto as taught by NetGram and start charging fee to recover operational costs.

**Conclusion**

Applicant is required under 37 CRF '1.111 (c) to consider the references fully when responding to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Naresh Vig  
Examiner  
Art Unit 3629